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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,546	10/10/2001	Gang An	UROC:018USD2	8133

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EXAMINER

RAWLINGS, STEPHEN L

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 10/21/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/974,546

Applicant(s)

AN ET AL.

Examiner

Stephen L. Rawlings, Ph.D.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 78-94 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 78-94 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The amendment filed October 10, 2001 in Paper No. 3 is acknowledged and has been entered. Claims 1-77 have been canceled. Claims 78-94 have been added.
2. Claims 78-94 are pending in the application and are currently subject to the following restriction.

#### ***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 78-85, insofar as the claims are drawn to a method for treating cancer comprising administering to a patient an agent that inhibits a peptide or polypeptide encoded by SEQ ID NO: 1 or a fragment thereof, classified, for example, in class 424, subclass 139.1.

Group II. Claims 78-85, insofar as the claims are drawn to a method for treating cancer comprising administering to a patient an agent that inhibits a peptide or polypeptide encoded by SEQ ID NO: 2 or a fragment thereof, classified, for example, in class 424, subclass 139.1.

Group III. Claims 78-94, insofar as the claims are drawn to a method for treating cancer comprising administering to a patient or a cell within a patient an agent that inhibits a peptide or polypeptide encoded by SEQ ID NO: 3 or a fragment thereof, classified, for example, in class 424, subclass 139.1.

Group IV. Claims 78-85, insofar as the claims are drawn to a method for treating cancer comprising administering to a patient an agent that inhibits

a peptide or polypeptide encoded by SEQ ID NO: 4 or a fragment thereof, classified, for example, in class 424, subclass 139.1.

Group V. Claims 78-85, insofar as the claims are drawn to a method for treating cancer comprising administering to a patient an agent that inhibits a peptide or polypeptide encoded by SEQ ID NO: 5 or a fragment thereof, classified, for example, in class 424, subclass 139.1.

Group VI. Claims 78-85, insofar as the claims are drawn to a method for treating cancer comprising administering to a patient an agent that inhibits a peptide or polypeptide encoded by SEQ ID NO: 10 or a fragment thereof, classified, for example, in class 424, subclass 139.1.

Group VII. Claims 78-85, insofar as the claims are drawn to a method for treating cancer comprising administering to a patient an agent that inhibits a peptide or polypeptide encoded by SEQ ID NO: 11 or a fragment thereof, classified, for example, in class 424, subclass 139.1.

Group VIII. Claims 78-85, insofar as the claims are drawn to a method for treating cancer comprising administering to a patient an agent that inhibits a peptide or polypeptide encoded by SEQ ID NO: 12 or a fragment thereof, classified, for example, in class 424, subclass 139.1.

Group IX. Claims 78-85, insofar as the claims are drawn to a method for treating cancer comprising administering to a patient an agent that inhibits a peptide or polypeptide encoded by SEQ ID NO: 13 or a fragment thereof, classified, for example, in class 424, subclass 139.1.

Group X. Claims 78-85, insofar as the claims are drawn to a method for treating cancer comprising administering to a patient an agent that inhibits

a peptide or polypeptide encoded by SEQ ID NO: 16 or a fragment thereof, classified, for example, in class 424, subclass 139.1.

Group XI. Claims 78-85, insofar as the claims are drawn to a method for treating cancer comprising administering to a patient an agent that inhibits a peptide or polypeptide encoded by SEQ ID NO: 17 or a fragment thereof, classified, for example, in class 424, subclass 139.1.

Group XII. Claims 78-85, insofar as the claims are drawn to a method for treating cancer comprising administering to a patient an agent that inhibits a peptide or polypeptide encoded by SEQ ID NO: 19 or a fragment thereof, classified, for example, in class 424, subclass 139.1.

Group XIII. Claims 78-85, insofar as the claims are drawn to a method for treating cancer comprising administering to a patient an agent that inhibits a peptide or polypeptide encoded by SEQ ID NO: 20 or a fragment thereof, classified, for example, in class 424, subclass 139.1.

Group XIV. Claims 78-85, insofar as the claims are drawn to a method for treating cancer comprising administering to a patient an agent that inhibits a peptide or polypeptide encoded by SEQ ID NO: 21 or a fragment thereof, classified, for example, in class 424, subclass 139.1.

Group XV. Claims 78-85, insofar as the claims are drawn to a method for treating cancer comprising administering to a patient an agent that inhibits a peptide or polypeptide encoded by SEQ ID NO: 22 or a fragment thereof, classified, for example, in class 424, subclass 139.1.

Group XVI. Claims 78-85, insofar as the claims are drawn to a method for treating cancer comprising administering to a patient an agent that inhibits

a peptide or polypeptide encoded by SEQ ID NO: 23 or a fragment thereof, classified, for example, in class 424, subclass 139.1.

Group XVII. Claims 78-85, insofar as the claims are drawn to a method for treating cancer comprising administering to a patient an agent that inhibits a peptide or polypeptide encoded by SEQ ID NO: 45 or a fragment thereof, classified, for example, in class 424, subclass 139.1.

Group XVIII. Claims 78-85, insofar as the claims are drawn to a method for treating cancer comprising administering to a patient an agent that inhibits a peptide or polypeptide encoded by SEQ ID NO: 46 or a fragment thereof, classified, for example, in class 424, subclass 139.1.

Group XIX. Claims 78-94, insofar as the claims are drawn to a method for treating cancer comprising administering to a patient or a cell within a patient an agent that inhibits a peptide or polypeptide encoded by SEQ ID NO: 83 or a fragment thereof, classified, for example, in class 424, subclass 139.1.

Group XX. Claims 78-94, insofar as the claims are drawn to a method for treating cancer comprising administering to a patient or a cell within a patient an agent that inhibits a peptide or polypeptide encoded by SEQ ID NO: 85 or a fragment thereof, classified, for example, in class 424, subclass 139.1.

4. The inventions are distinct, each from the other because of the following reasons:  
The inventions in groups I-XX are disclosed as materially different methods that differ at least in objectives, method steps, reagents and/or doses and/or schedules used, response variables, assays for end products and/or results, and criteria for success, and therefore the claimed methods are distinct.

5. Because these inventions are distinct for the reasons given above and also because the search required for any one group is not required for any other group and/or the inventions have acquired a separate status in the art as shown by their different classification or their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Claim 78 is generic to a plurality of disclosed patentably distinct species comprising the invention of claim 78 wherein said cancer is selected from the group of cancers consisting of bladder cancer, breast cancer, and prostate cancer.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Rawlings, Ph.D. whose telephone number is

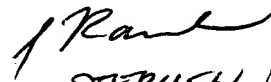
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(703) 305-3008. The examiner can normally be reached on Monday-Friday, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C. Caputa, Ph.D. can be reached on (703) 308-3995. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Stephen L. Rawlings, Ph.D.  
Examiner  
Art Unit 1642

  
STEPHEN RAWLINGS

slr  
October 20, 2003